



[3510-16-P]

**DEPARTMENT OF COMMERCE**

**United States Patent and Trademark Office**

**[Docket No. PTO-P-2011-0064]**

**Electronic Delivery of Search Results from the United States Patent and Trademark Office to the European Patent Office**

**AGENCY:** United States Patent and Trademark Office, Commerce.

**ACTION:** Notice.

**SUMMARY:** The United States Patent and Trademark Office (USPTO) has recently begun electronic delivery of search results from U.S. patent applications to the European Patent Office (EPO) to assist U.S. applicants who later file in the EPO to comply with amended Rule 141(1) of the EPO's implementing regulations to the European Patent Convention (EPC). As a result, U.S. applicants subject to amended Rule 141(1) EPC will not need to separately file their U.S. search results with the EPO, thereby providing time and cost savings to these applicants .

**FOR FURTHER INFORMATION CONTACT:** Susy Tsang-Foster, Legal Advisor or Brian Hanlon, Director, Office of Patent Legal Administration, Office of the Associate Commissioner for Patent Examination Policy, by telephone at (571) 272–7711 or (571) 272–5047; or by mail addressed to: Mail Stop Comments - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313–1450, marked to the attention of Susy Tsang-Foster.

**SUPPLEMENTARY INFORMATION:** Amended Rule 141(1) EPC (Information on Prior Art), which went into effect on January 1, 2011, applies to all European patent applications filed on or after January 1, 2011. Amended Rule 141(1) EPC requires applicants to file with the EPO a copy of the search results from a previously filed patent application to which the European patent application claims priority. See Notice from the European Patent Office dated 28 July 2010 concerning amended Rule 141 EPC and new Rule 70b EPC – utilisation scheme, OJ EPO 2010, 410.

To assist U.S. applicants who later file in the EPO to comply with amended Rule 141(1) EPC, in October 2011, the USPTO began electronically providing the search results (Notice of References Cited, form PTO-892) from examined U.S. patent applications to the EPO. Due to the confidential nature of U.S. patent applications, however, search results from U.S. patent applications are being provided only if one of the following criteria is met: (1) the U.S. patent application is publicly available (i.e., published or patented), or (2) an authorized party has submitted written consent to transmit the search results from the U.S. patent application to the EPO by completing Form PTO/SB/69 and

the U.S. patent application has cleared national security review. As a result, an EPO applicant claiming priority to a U.S. patent application that meets one of the above criteria will not need to separately file a copy of the search results from the U.S. patent application with the EPO. See Notice from the European Patent Office dated 9 December 2010 concerning exemption under Rule 141(2) EPC from filing a copy of the search results – utilisation scheme, OJ EPO 2011, 64.

Form PTO/SB/69 titled “Certification and Authorization to Permit Access to Search Results by the European Patent Office (EPO)” will be available on the USPTO Web site at <http://www.uspto.gov/forms/index.jsp>. A properly completed Form PTO/SB/69 by an authorized party in accordance with 37 CFR 1.14(c) provides the USPTO with written consent to electronically deliver the search results from an unpublished U.S. patent application to the EPO. The Office of Management and Budget (OMB) has determined that, under 5 CFR 1320.3(h), Form PTO/SB/69 does not collect “information” within the meaning of the Paperwork Reduction Act of 1995. Authorized parties for a U.S. patent application are encouraged to submit Form PTO/SB/69 prior to the filing of a subsequent European patent application, in which priority is claimed to a U.S. patent application. The EPO has agreed to maintain the confidentiality of the unpublished search results received from the USPTO.

Once a U.S. patent application is published under 35 U.S.C. 122(b), it is open to the public, and in this instance, consent from an authorized party for the U.S. patent application is not necessary for the USPTO to deliver the search results to the EPO. The

USPTO is authorized to electronically deliver search results to the EPO by 35 U.S.C.

2(b)(11), which permits it to conduct programs, studies, or exchanges of items or services regarding domestic and international intellectual property law and the effectiveness of intellectual property protection domestically and throughout the world, and by 35 U.S.C.

2(b)(6), which permits it to use services, records, facilities, or personnel of a foreign patent and trademark office or international organization to perform functions on its behalf.

This electronic delivery of search results will benefit patent applicants who file with the USPTO and subsequently with the EPO as they will be relieved of the effort and expense of filing a copy of the search results from a U.S. priority patent application with the EPO. Additionally, no fee is required for the electronic delivery of search results from the USPTO to the EPO.

Date: December 20, 2011

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David J. Kappos  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office

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